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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/324,601	06/02/1999	STEVEN C. ROBERTSON		1766

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EXAMINER

FADOK, MARK A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 05/14/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/324,601

Applicant(s)

ROBERTSON, STEVEN C.

Examiner

Mark A Fadok

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Amendment

The Examiner is in receipt of applicant's response to office action dated 1/30/02, which was received by the office on 4/15/2002. The response has been examined and the arguments taken into consideration, however, the rejection as stated in the previous rejection stands and is restated below.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Von Bergen as applied to claim 1-18 above, and further in view of US 5,953,710, herein referred to as Fleming. Von Bergen shows all the limitations of the claims except as follows:**

In regards to claim 1, Von Bergen teaches a central location for controlling the gift certificate process and a series of remote locations, but does not specifically mention user database, merchant database, manufacturers database containing authentication information of registrants. Fleming et al. teaches Bank Accounts **Database 22** represented in **FIGS. 2-11** may be a network of databases maintained on different computers at more than one location. This invention may be used with credit cards

issued by merchants, phone companies, and other entities (col. 6, lines 7-19). It would be obvious to a person of ordinary skill in the art to include in Von Bergen the step of having a user database, merchant database, manufacturers database containing authentication information of registrants, because the information would be needed at each location to effect the transaction.

In regards to claim 3, Von Bergen teaches the purchase of an electronic gift certificate, but does not specifically mention restricting the use of the gift certificate. Fleming teaches allowing a parent to use the system to restrict the number of purchases made by the child (col. 3, lines 50-52). It would be obvious to a person of ordinary skill in the art to include in Von Bergen the step of restricting the use of the gift certificate as taught in Fleming, because the gift could be given to a minor who might spend the money in a place undesirable to the gift giver.

In regards to claims 4,5,10 Von Bergen teaches the purchase of an electronic gift certificate, but does not specifically mention tracking the use of the gift certificate. Fleming teaches a Parent Statement List which includes parent and child debit expenditures, parent and child credits, parent and child payments, parent requests including increase, decrease, enable, disable, and limit requests, as well as any service charges, interest, or fees for the parent and child. Note: the parent statement includes child purchases. Transactions on this list are shown on a parent's account statement (col. 13, lines 45-51). It would be obvious to a person of ordinary skill in the art to include in Von Bergen the step of tracking the use of the gift certificate as taught in

Fleming, because the gift could be given to a minor who might spend the money in a place undesirable to the gift giver.

In regards to claims 11,12,13,14,15,16, 17 and 18, Von Bergen and Fleming teach a method of limiting transactions on an electronic gift certificate, but do not specifically mention those restrictions that are noted in claims 11,12,13,14,15,16, 17 and 18 of the instant application. The examiner makes note that it is well known in the art to place limitations on credit and debit cards and that these restrictions are not limited, therefore since Von Bergen and Fleming have a method that allows for restriction the level of restriction is considered infinite.

3. Claims 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,914,472, herein referred to as Foladare et al as applied to claim 1-22 above, and further in view of Von Bergen. Foladare et al shows all the limitations of the claims except as follows:

In regards to claim 19-22, Foladare et al teaches an apparatus that processes purchases with restricted credit/debit cards, but does not specifically mention Gift certificates or contributions going to charity. Von Bergen teaches online gift certificates where residual funds can be donated to a choice of charities. It would be obvious to a person of ordinary skill in the art to include in Foladare et al online gift certificates where residual funds can be donated to a choice of charities as taught by Von Bergen, because a gift certificate is akin to that of a debit card with a fixed value and is well known in the art. Also, since most transactions will result in a residual value on the

account, rather than lose the money, giving it to charity would be a more appealing option.

Response to Arguments

Applicant's arguments filed 4/15/2002 have been fully considered but they are not persuasive.

In regards to applicant's statement that Von Bergen et al has a publish date that is less than 12 months from the filing date and that said reference was improperly applied. The examiner points out that the rejection was based on 35 U.S.C. 103(a) not 102(b) as the applicant has stated and was therefore properly applied as follows:

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

The above statute as set forth in USC 102(a) allows the consideration of art that was published or otherwise available to the public at any time before the effective filing date of the instant application. The applicant may consider entering an affidavit or declaration of prior invention as set forth under Title 37 Rule § 1.131 to overcome this rejection.

Applicant argues that the combination of Von Bergen and Fleming makes no reference to manufacturer information being stored on the central system only retailers, and that transaction information is maintained by a bank and not within the system. VonBergen can be used at any merchant site, further, it is well known in the art that some manufacturers maintain their own merchant web site where purchases can be transacted, therefore, the information maintained at C/Base's central database could be

that of a retailer a manufacturer or any other entity that does business on the internet. The applicant goes on to argue that the combination of VonBergen/Fleming limit transactions to a "bank". To the contrary, all "transaction are funneled through C/Bases banking system."

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a) category of product or service; b) age range; c) date range; d) and merchant are not recited in the rejected claim. Although the claim is interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicants argument that VonBergen/Fleming provide only a static list and lack a dynamic query. Fleming (FIG 3) Item 66 teaches a database query retrieval of available credit for the account. It is noted that account queries based on numerous different categories is old and well known in the art, such as a users inquiry pertaining to a credit card balance and/or latest transactions.

In response to applicant's argument concerning claim 10, the Examiner agrees with the applicant that the rejection for claims 4 and 5 are not related to claim 10. However, the argument stated for claims 11-16 (claims dependent on claim 10) was the intended rejection for claim 10. Therefore, it is believed that the typographical error was evident to the applicant and claim 10 will be addressed with the same argument formally provide for claim 10's dependent claims.

In regards to claims 10-16 applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

In response to claims 19-22 applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "automatic and reoccurring anonymous contributions") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's arguments to the rejection of claims 2,6,7,8, and 9, that the Examiner made no argument against them. The examiner refers the applicant to page 2, paragraph 3 and the statement "VonBergen shows all the limitations the claims" (claims 1-18) except as noted below. Therefore all the limitations not specifically argued can be found in the teachings of VonBergen.

Allowable Subject Matter

In response to applicant's request for the Examiner to offer constructive assistance pursuant to MPEP 707.07(j), the Examiner was unable to find suitable subject matter that would result in an allowable claim.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A Fadok whose telephone number is (703) 605-4252. The examiner can normally be reached on Monday to Thursday 8:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703) 308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


Mark Fadok
May 13, 2002


WYNN COGGINS
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